

The following is a mini-lecture which was prepared for the Inventor's Expo in Baltimore in 1980.

The lecture is included to give you an idea of what a patent is and what it does and what it means when an examiner rejects your claims in an application for a patent.

RADUAZO'S MINI-LECTURE FOR INVENTORS

A patent is a grant from the Government which gives the inventor or patent holder the right to exclude others from making, using or selling whatever is CLAIMED in the patent.

The CLAIMS are the heart and soul of a patent. A good claim may be worth money. A bad claim is always worthless.

To be entitled to a patent an Applicant's Invention AS CLAIMED must be:

1. different from the prior art (35 USC 102)
2. unobvious over the prior art (35 USC 103) and,
3. adequately disclosed and claimed (35 USC 112).

To see how this works look at the following three claims: I claim,

1. A vehicle having a front and a rear with a seat facing the front and four wheels including a front pair of wheels, and a back pair of wheels.

2. A vehicle having a front and a rear with a seat facing the front and four wheels including a front pair of wheels, and a back pair of wheels, and further including an engine supported primarily above said rear wheels.

3. A vehicle having a front and a rear with a seat

facing the front and four wheels including a front pair of wheels and a back pair of wheels, said vehicle further including an engine supported primarily by said rear wheels, and a power train extending from said engine to said front wheels whereby said rearwardly supported engine can provide motive power to said front wheels.

These claims have progressively narrower scope. Claims 2 and 3 could have been written in dependent form as follows:

2. A vehicle as in claim 1 and further including an engine supported primarily above said rear wheels.

3. A vehicle as in claim 2 and further including a power train extending from said engine to said front wheels whereby said rearwardly supported engine can provide motive power to said front wheels.

Claim 1 if granted would permit the patent holder to exclude others in the United States from making cars, trucks, and even wagons having a seat and four wheels.

Both claims 1 and 2 are not patentable under 35 USC 102 because the VW Bug, which has both four wheels and an engine in the rear, was known and used in this country more than one year prior to today's date.

If we assume that the VW Bug and a 1974 Cadillac having a front supported engine and rear wheel drive comprise the prior art, then, 35 USC 102 does not apply, but 35 USC 103 may apply.

To determine the patentability of claim 3 one must answer the question: Given a front engine car with rear wheel drive and

a rear engine car with rear wheel drive, would it have been obvious to provide a rear engine car with front wheel drive?

The answer to this question is not always clear. One must consider the skill of a person having ordinary competence in the car building industry. What factors would cause one of ordinary skill to make this combination, and what new and unobvious benefits are derived from this unique combination of features.

To define a patentable invention the prospective inventor-claim writer must add enough limitations to his claims to define something which is both different from what is in the prior art and unobvious over the prior art.

Claim 3 if granted would give the inventor the right to exclude others from making or using rear engine cars with front wheel drive, and rear engine cars with four wheel drive.

The applicant, as a general rule, does not wish to burden his claims with frivolous or unnecessary limitations. Claim 3 is valuable only if someone wants to make a rear engine car with front wheel drive and is willing to pay the patent holder money for the privilege of making such a car.

One would not for example wish to put in his claim the limitation that the wheels are made of chrome plated steel, because car manufacturers would be able to make the inventor's car with wheels of painted steel with out infringing the claim, and the chances are they would do just that to avoid paying the patent holder royalties.

In the general scheme of things the Patent Examiner occupies a position of quasi-prosecuting attorney and judge. As

prosecuting attorney he is required to check the applicant's disclosure, to read the claims, to search out the best prior art, and to make all pertinent objections and rejections to the application which are within reason.

It is the examiner's responsibility to ensure that the applications which he handles comply with all laws passed by Congress (Title 35 of the United States Code), all regulations set forth by the Commissioner of Patents (37 Code of Federal Regulations, and all required procedures (Manual of Patent Examining Procedures).

On occasion the Examiner may be able to help the Applicant by writing allowable claims, but first it must be clear to the Examiner that there is an allowable concept or idea in the applicants disclosure, and the time an Examiner can spend on each application is severely limited.

In his role as a judge, the Examiner is required to listen to the arguments for patentability presented by the applicant, and taking these arguments into consideration, he is required render what he considers to be a fair and impartial decision.

With the forgoing guidelines in mind the following action is provided for the applicant's consideration.